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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,845	08/06/2004	David G. Koch	YORK.US.2	4844

24111 7590 08/07/2008
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EXAMINER

BARTOSIK, ANTHONY N

ART UNIT	PAPER NUMBER
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3635

NOTIFICATION DATE	DELIVERY MODE
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08/07/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/710,845	Applicant(s) KOCH ET AL.	
	Examiner ANTHONY N. BARTOSIK	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is Second Action Non-Final sent in response to Applicant's Remarks of 2/19/2008.

Response to Arguments

1. Applicant's arguments filed 2/19/2008, with respect to the First Office Action of 10/19/2007 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the references below. Furthermore, a rejection under 35 U.S.C. 102(e)/103(a), as set forth in MPEP 804, has also been included in regards to the Lolley et al. reference which was not addressed in the First Office Action.

Claim Rejections - 35 USC § 112

2. Claims 2 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 12 are drafted as improper Markush claims, i.e. "made of at least on taken from the group." See MPEP 2173.05(h)

Claim Rejections in Relation to the Lolley et al. Double Patenting Reference

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 10, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lolley et al. (US 6,696,141).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

5. In Re claim 1, Figure 1 of Lolley et al. discloses a flashing membrane (12), the flashing membrane (12) having a first side and a second side opposite the first side, a reinforcing cloth (14) adhered to the flashing membrane (12) first side, and a wicking cloth (14) adhered to the flashing membrane (12) second side. The Examiner is interpreting the top layer (14) to be the wicking layer.

6. In Re claim 2, Lolley et al. discloses the flashing membrane being a sheet of material made of at least one taken from the group consisting of copper, PVC, polyethylene, and stainless steel.

7. In Re claim 3, Lolley et al. discloses the flashing membrane being made of copper sheet weighing between three and seven ounces per square foot and is between 0.0036 and 0.0094 inches thick.

8. In Re claim 4, Lolley et al. discloses the reinforcing cloth being fiberglass.

9. In Re claim 10, Figure 1 of Lolley et al. discloses an adhesive disposed between the reinforcing cloth and the flashing membrane, and between the wicking cloth and the flashing membrane.

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10. In Re claim 21, Figures 1 and 3 of Lolley et al. disclose an inner wall (36), an outer wall (34), and a combination through-wall masonry flashing and drainage device, the device (10) comprising a flashing membrane (12) having a first side and a second side opposite the first side, a reinforcing cloth (14 – bottom) adhered to the flashing membrane (12) first side, and a wicking cloth (14 – top) adhered to the flashing membrane (12) second side; the device having a first edge and a second edge opposite the first edge, wherein the first edge of the device is secured to the inner wall (36) with the wicking cloth (14 – top) facing up, and the second edge of the device is secured beyond the outer wall (34), such that water between the inner wall (36) and outer wall (34) is drawn through a mortar joint at the base of the outer wall to the outside of the outer wall by the wicking action (14 – top) of the wicking cloth (14 – top) without the need for vents.

11. In Re claims 22 and 23, Figure 3 of Lolley et al. disclose the limitations of claims 22 and 23.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5, 6, and 16 are rejected under 35 U.S.C. 103(a) as being obvious over Lolley et al. (US 6,696,141).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

14. In Re claims 5, 6, and 16, Col. 3 Line 45 of Lolley et al. discloses the claimed invention except for the particulars to the dimensions of the reinforcing layer and the wicking cloth. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have properly dimensioned both the reinforcing and wicking layers as claimed because applicant

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failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being dimensioned to meet the limitation as claimed. See MPEP 2144.04(IV)(A) citing *In re Rose*, 220 F.2d 459 (CCPA 1955): claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the

Further, it is well known in the art to use a properly dimensioned apparatus in order to avoid unwanted failure of said apparatus and properly dimensioning the wicking cloth does not reach an unpredicted result.

15. Claims 7-9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lolley et al. (US 6,696,141) in view of Sourlis (US 6,023,892).

16. In Re claims 7 and 17, Lolley et al. discloses the claimed invention except for the particulars of the wicking material. It is well known in the art to use a variety of materials to wick water away from a surface. Col. 4 Lines 45-47 of Sourlis teach the use of polyethylene or polyester within a wall for wicking water away. It therefore would have been obvious to one skilled in the art at the time of the invention to substitute the material of Lolley et al. for the polyethylene or polyester as taught by Sourlis in order to wick water away.

17. In Re claims 8 and 9, the combination of claim 7 teaches the wicking cloth transporting liquid through capillary action and gravity.

18. Claims 11-15, 18-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lolley et al. (US 6,696,141) in view of Cohen et al. (US 2,005,221).

19. In Re claims 11 and 24, Lolley et al. teaches a flashing membrane, the flashing membrane (12) having a first side and a second side opposite the first side, a first reinforcing cloth (14 – top) adhered to the flashing membrane first side, a second reinforcing cloth (14 – bottom) adhered to the flashing membrane (12) second side. Lolley et al. however does not disclose a wicking cloth adhered to the second reinforcing cloth.

It is well known in the field of flashing for masonry walls to include wicking material on flashing in order to draw water out from between inner and outer walls. Col. 2 Lines 40-55 of Cohen et al. teaches the use a wicking cloth on a flashing membrane for drawing away moisture. It therefore would have been obvious to one skilled in the art at the time of the invention to include a wicking cloth on top of the reinforcing cloth of the first side in order to more effectively wick water away from the interior of masonry walls.

20. In Re claims 12-15 Lolley et al. discloses the claimed invention.

21. In Re claims 18 and 19, Cohen et al. discloses the limitations of transporting liquid.

22. In Re claim 20, the combination of Lolley et al. and Cohen et al. teaches an adhesive (16 of Lolley et al.) disposed between the reinforcing cloths and the flashing membrane, and between the wicking cloth (Cohen et al. teaches bonding the wicking cloth).

Claim Rejections Regarding Newly Issued Rejections

Claim Rejections - 35 USC § 102

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

24. Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al. (US 2,005,221).

25. In Re claim 1, Figure 3 of Cohen et al. discloses a flashing membrane (10), the flashing membrane (10) having a first side and a second side opposite the first side, a reinforcing cloth (11 – bottom; Col. 1, Lines 27-31) adhered to the flashing membrane

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(10) first side, and a wicking cloth (11 – top) adhered to the flashing membrane (10) second side.

26. In Re claim 2, Col. 1 Line 45 of Cohen et al. discloses the flashing membrane being a sheet of material made of at least one taken from the group consisting of **copper**, PVC, polyethylene, and stainless steel.

27. In Re claims 8 and 9, Figure 3 of Cohen et al. discloses liquid transport through gravity and capillary action.

28. In Re claim 10, Figure 3 of Cohon et al. discloses an adhesive disposed between the reinforcing cloth and the flashing membrane, and between the wicking cloth and the flashing membrane.

29. Claims 11, 12, 14, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rizzo (US 3,497,417).

30. In Re claim 11, Figure 4 of Rizzo discloses a flashing membrane (60 & 62), the flashing membrane (60 & 62) having a first side and a second side opposite the first side, a first reinforcing cloth (80) adhered (86) to the flashing membrane (60 & 62) first side, a second reinforcing cloth (66) adhered to (74) the flashing membrane (60 & 62) second side, and a wicking cloth (68) adhered to the second reinforcing cloth (66).

The Examiner is interpreting wicking to mean, to drain, as defined by Merriam-Websters Online Dictionary. wick. (2008). In Merriam-Webster Online Dictionary.

31. In Re claim 12, Col. 5 Lines 4-6 of Rizzo disclose flashing membrane is a sheet of material made of at least one taken from the group consisting of **copper**, PVC, polyethylene, and stainless steel.

32. In Re claim 14, Col. 5 Line 15 of Rizzo discloses reinforcing cloths that are fiberglass.

33. In Re claim 20, Col. 5 Lines 4-17 of Rizzo discloses an adhesive disposed between the reinforcing cloths and the flashing membrane, and between the wicking cloth and the second reinforcing cloth.

Claim Rejections - 35 USC § 103

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2,005,221).

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36. In Re claims 3 and 6, Col. 3 Line 45 of Cohen et al. discloses the claimed invention except for the particulars to the dimensions of the flashing membrane and the wicking cloth. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have properly dimensioned both the flashing membrane and wicking layers as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being dimensioned to meet the limitation as claimed. See MPEP 2144.04.

Further, it is well known in the art to use a properly dimensioned apparatus in order to avoid unwanted failure of said apparatus and properly dimensioning the wicking cloth does not reach an unpredicted result.

37. In Re claims 4 and 5, Cohen et al. discloses the claimed invention except for the reinforcing cloth being fiberglass and weighing between 0.2 and 0.3 ounces per square foot. It would have been obvious to one skilled in the art at the time of the invention to use fiberglass that weighed between 0.2 and 0.3 since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. MPEP 2144.07.

38. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2,005,221) in view of Sournalis (US 6,023,892).

39. In Re claims 7 and 17, Cohen et al. discloses the claimed invention except for the particulars of the wicking material. It is well known in the art to use a variety of materials to wick water away from a surface. Col. 4 Lines 45-47 of Sourlis teach the use of polyethylene or polyester within a wall for wicking water away. It therefore would have been obvious to one skilled in the art at the time of the invention to substitute the material of Lolley et al. for the polyethylene or polyester as taught by Sourlis in order to more effectively wick water away.

40. Claims 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo (US 3,497,417).

41. In Re claims 13 and 15, and 16, Col. 3 Line 45 of Cohen et al. discloses the claimed invention except for the particulars to the dimensions of the flashing membrane and the wicking cloth. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have properly dimensioned both the flashing membrane and wicking layers as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being dimensioned to meet the limitation as claimed. See MPEP 2144.04.

42. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sourlis (US 6,023,892) in view of Cohen et al. (US 2,005,221).

43. In Re claim 21, Figure 1 of Sournalis teaches an inner wall (12), an outer wall (14), and a combination through-wall masonry flashing and drainage device (20), the device (20) comprising a flashing membrane (20) having a first side and a second side opposite the first side, and a wicking cloth (32) adhered to the flashing membrane (30) second side; the device (20) having a first edge and a second edge opposite the first edge,

wherein the first edge of the device (20) is secured to the inner wall (12) with the wicking cloth (32) facing up, and the second edge of the device (20) is secured beyond the outer wall (14), such that water between the inner wall (12) and outer wall (14) is drawn through a mortar joint at the base of the outer wall (14) to the outside of the outer wall (14) by the wicking action of the wicking cloth (32) without the need for vents.

Sournalis, however, fails to disclose a reinforcing cloth adhered to the first side of a flashing member.

Figure 3 of Cohen et al. teaches a reinforcing cloth (32) (11 – bottom; Col. 1, Lines 27-31) adhered to a flashing membrane to retain the strength and rigidity of the flashing membrane. It would have been obvious to one skilled in the art at the time of the invention to include a reinforcing layer on the bottom of the flashing as taught by Cohen et al. in order to strengthen the device (20).

44. In Re claim 22, Figure 3 of Sournalis discloses the first edge is secured at a higher elevation on the inner wall (12) than the second edge is secured to the outer wall (14).

45. In Re claim 23, Figure 3 of Sournalis discloses a horizontal concrete support upon which the inner wall (12) and outer wall (14) are supported, wherein the device (20) second edge is disposed between and beyond the outer wall (14) and concrete support.

Response to Amendment

46. The Affidavits filed on 2/19/2008 under 37 CFR 1.131 have been considered but were found to be ineffective as they are self serving and not drawn to the claims, but to the product which is far more specific than the limitations contained within the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY N. BARTOSIK whose telephone number is (571)270-3112. The examiner can normally be reached on M-F 7:30-5:00; E.D.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
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/A. N. B./
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